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Brief of Fisher for Petitioners

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Supreme Court of the United States.

October Term, 1899.

CLARENCE W. HOBBS ET AL.,
Petitioners,

vs.

FRED H. BEACH,
Respondent.

BRIEF FOR PETITIONERS.

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McGILL & WALLACE, Law Printers, Washington, D. C.

IN THE

Supreme Court of the United States.

In the Matter of the Petition of Clarence W. Hobbs and Others for a Writ of Certiorari to Bring up the Cross-Appeal Case of Fred H. Beach *vs.* Clarence W. Hobbs et al. and Clarence W. Hobbs et al. *vs.* Fred H. Beach for Review and Determination.

BRIEF IN SUPPORT OF PETITION.

First. The petition presents a conflict between the decisions of the Circuit Court of Appeals for the First Circuit and the Court of Appeals for the Second Circuit as to the scope of the 1st, 2d, and 3d claims of Beach's reissue letters-patent No. 11,167 of May 26, 1891, for Machine for Attaching Stays to the Corners of Boxes, and having about nine years more to run.

In the Second Circuit the law is that these claims cover *every* box-corner stay machine containing in combination any kind of a pasting mechanism, any kind of a feeding mechanism, and any kind of a severing mechanism with clamping dies having diverging working faces.

Beach *v.* Inman, 24 C. C. A., 165.

And the Court of Appeals for the Second Circuit has even enlarged and emphasized its original interpreta-

tion of these claims in Beach *v.* Inman, 24 C. C. A., 408–410, wherein, on a motion for a preliminary injunction, Inman was enjoined, although his clamping mechanism was apparently wholly different in construction and mode of operation from the clamping dies set forth in the Beach patent.

The Court of Appeals for the Second Circuit, in these suits against Inman, who appears to have unsuccessfully disputed with Beach the question of priority of invention in the Patent Office, seems to have cast to the winds the doctrine of known substitutes as stated in Rees *v.* Gould, 15 Wall., 193–195, where it was held that—

"If the ingredient substituted [in defendant's machine] was (1) a new one, or (2) performs a substantially different function, or (3) was not known at the date of plaintiff's patent as a proper substitute for the one omitted from his patented combination,"

the defendant does not infringe. This doctrine, it is thought, has been uniformly followed by this Court in—

Gill *v.* Wells, 22 Wall., 15, 16;
Fuller *v.* Yentzer, 94 U. S., 299–307;
Imhaueser *v.* Buerk, 101 U. S., 647–664;
Clough *v.* Barker, 106 U. S., 166, 167;
Duff *v.* Sterling Pump Co., 107 U. S., 636–639;
Signal Co. *v.* Signal Co., 114 U. S., 87–103;
Morley Sewing Machine Co. *v.* Lancaster, 129 U. S., 263;
Westinghouse *v.* Boyden Power Brake Co., 170 U. S., 537.

It may not be amiss to remind the Court that analysis of the Morley case shows that every one of the elements in the defendant's machine was either copied from the Morley patent or was a known device which in mechanics was recognized as a proper substitute for the corresponding device used by Morley to effect the same result.

The Court of Appeals for the First Circuit follows the foregoing Supreme Court cases on the question of what the law is, touching the question of infringement of combination claims, and repudiates the new and strange doctrine of the Court of Appeals for the Second Circuit. The Court of Appeals for the First Circuit says:

"It would be giving too broad a construction to the Beach patent to hold that it covered every combination of clamping dies, feeding, pasting, and cutting mechanism which accomplished the same result;"

but as the Court of Appeals for the First Circuit found (erroneously, it is believed) that defendant's feeding mechanism was a known equivalent for Beach's, at the date of Beach's patent, it held defendant's machine as an infringement of the 1st, 2nd, and 3rd claims of Beach's patent. But the Court of Appeals for the First Circuit left it open to petitioners to change over their enjoined machines and to build and sell new ones containing dies having diverging working faces, in combination with pasting, feeding, and cutting mechanisms, provided the new clamping dies, or the new pasting mechanism, or the new feeding mechanism, or the new severing mechanism—any one or more of them—be not known substitutes for, or, in substance, the same as Beach's corresponding elements. That this is good law is supposed to be perfectly clear, not only from the decisions, cited above, of this Honorable Court, but also from Burr *v.* Duryee, 1 Wall., 531–579, wherein it is said "an infringement involves substantial identity," and wherein certain recurrent and supposedly "equitable," because vague and indefinite, ideas of what constitutes equivalency in patent law are strongly condemned.

By reason of said conflict of decisions, neither these petitioners nor any member of the public who may be engaged in the manufacture, use or sale of box-corner

stay machines can reasonably hope to do such business within the Second Circuit because of the new and strange doctrine there enunciated in the suits against Inman, wherein Beach's first three claims are held to cover EVERY box-corner stay machine containing any kind of clamping dies; any kind of severing mechanism; any kind of pasting mechanism, "WITHOUT ANY RESTRICTION TO THE DETAILS OF MECHANICAL CONSTRUCTION."

Beach *v.* Inman, 18 C. C. A., 169.

This interpretation his honor, Judge Putnam, subsequently refused to follow, pronouncing it a dictum and unsupported by authority. (Beach *v.* Hobbs, 82 Fed. Rep., 916.) And the Court of Appeals for the First Circuit also refused to follow it in the cross-appeal case now sought to be brought up.

But which of these two antagonistic Appellate Court decisions courts in other districts and circuits will follow no man can tell (Pelzer *v.* Newhall, 93 Fed. Rep. 685), and it is because of this uncertainty as to what the legal scope of Beach's first three claims really is, and which of these two antagonistic conclusions other courts may adopt, and to ascertain what, if any, limits, are to be placed upon the scope of these claims during the next eight or nine years, that these petitioners are now come to the Supreme Court of the United States.

If petitioners happily reconstruct their machines so that the Court of Appeals for the First Circuit shall say there is no infringement, it will avail petitioners but little, for under the doctrine of the Second Circuit the great commercial State of New York will be closed to petitioners as well as the other States in that Circuit. Even to substitute a new, substantially different, and wholly unknown element, or elements, for any one or more of the functionally-recited elements of Beach, in

petitioners' machines in the Second Circuit, will subject such machines to preliminary and perpetual injunctions under the doctrine of the Court of Appeals for the Second Circuit.

In a word, the situation is this: by reason of the diversity of opinion of the two Appellate Courts, petitioners can not, with any reasonable business prudence, proceed with the manufacture, use or sale of any kind of box-corner staying machines comprising, in operative combination, any kind of opposing clamping dies with any kind of severing mechanism, any kind of feeding mechanism and any kind of pasting mechanism, unless they are willing to confine their business to the First Circuit, submit to injunctions in the Second Circuit, and run for luck in the remaining circuits.

These two Courts of Appeal have made the Beach patent, which is, in point of *good* law, of the same scope throughout the United States and Territories thereof, one kind of a monopoly in Vermont, New York and Connecticut, and a legally dissimilar kind of a monopoly in Maine, New Hampshire, Massachusetts and Rhode Island; and it is submitted that this Honorable Court should correct so glaring a diversity of interpretation, not only in the interests of petitioners, whose machines are outstanding in both circuits, but also in the interests of users of said machines.

Second. It is submitted also that this Honorable Court should enforce against the Beach patent, in respect of its 1st, 2nd, and 3rd claims, the reiterated and plain rule that a patentee is bound by limitations imposed upon patent claims by the Commissioner of Patents as prerequisites to allowance, and hold, as did his honor, Judge Putnam, that the words "substantially as described" are to be read after every element of Beach's

first, second, and third claims, and materially qualify the legal interpretation of these claims, the decision of the Court of Appeals for the Second Circuit to the contrary notwithstanding.

If the decisions of this Court in Morgan Envelope Co. *v.* Albany Paper Co., 152 U. S., 425, and cases cited, touching the effect of acquiescences in rejections are good law, it is perfectly clear from the file wrapper and contents of Beach's original patent (pp. 241–277 of Certified Record) that Beach's first, second, and third claims are to be read as stated in the right-hand column of the following parallel. The first thing to do is to obtain the legal meaning of the claims, and the second thing to do is to consider their scope with reference to petitioners' machines:

The Patent Claims.	The Claims According to Legal Construction from Beach's File Wrapper and Contents.
1. The combination, with opposing clamping dies having diverging working faces, of	1. The combination with opposing clamping dies having diverging working faces, of
a feeding mechanism constructed to deliver stay-strips between said clamping dies,	feed rollers M N operating in connection with an elastic bed L consisting of a series of parallel bars or wires *l*, *l*, *l*, which are secured at their ends in the frame at either side of the rollers M and N, the lower feed-roller N being mounted to turn freely in its bearings and being provided with a plurality of circumferential grooves to receive the bars or wires *l*, *l*, *l*, of the elastic bed L, the narrow annular flanges or ribs formed by said grooves projecting upwardly between said bars or wires, so as to bear upon the under surface of the stay-strip; and said roller N being mounted in a movable frame N^1 sustained by a spring-arm *n* which holds the roller N against the stay-strip,
and	and

a pasting mechanism for rendering adhesive the stay-strips,

said clamping dies being constructed to co-operate in pressing upon interposed box-corners the adhesive stay-strips, substantially as described.

2. The combination, with opposing clamping dies having diverging working faces, said clamping dies being arranged to co-operate in pressing adhesive fastening-strips upon interposed box-corners, a feeding mechanism constructed to feed forward a continuous fastening-strip,

and

a cutter for severing the said continuous strip into stay-strips of suitable lengths, substantially as described.

a pasting or gluing roller O mounted in bearings over and extending into a well or receptacle J and over which the strip passes from the reel K,

said clamping dies being constructed to co-operate in pressing upon interposed box-corners the adhesive stay-strips

obtained by cutting them off a continuous strip coming from one side of an inclined wall of the supporting die —

2. The combination of opposing clamping dies having diverging working surfaces, said clamping-dies being arranged to co-operate in pressing adhesive stay-strips upon interposed box-corners, feed-rollers M N operating in connection with an elastic bed L consisting of a series of parallel bars or wires *l*, *l*, *l*, which are secured at their ends in the frame at either side of the rollers M and N, the lower-feed roller N being mounted to turn freely in its bearings and being provided with a plurality of circumferential grooves to receive the bars or wires *l*, *l*, *l* of the elastic bed L, the narrow annular flanges or ribs formed by said grooves projecting upwardly between said bars or wires, so as to bear upon the under surface of the stay-strip; and said roller N being mounted in a movable frame N^1, sustained by a spring-arm *n* which holds the roller N against the stay-strip

and

a stationary blade or cutter P secured to the machine frame at one side of the clamping dies, and a vibrating knife or cutter Q pivoted to said frame, the movable blade or cutter Q, being extended at its inner end past its pivotal point, so as to form a projecting arm Q^1 which is pivoted at its rear end to a vertical slide R, which is held in the guide R^1 on the machine-frame, and is adapted to move vertically therein, said slide bar R being provided with a stud *r* which rests in a cam groove c^3 of

3. The combination with opposing clamping-dies having diverging working-faces, said clamping-dies being arranged to co-operate in pressing an adhesive fastening-strip upon the corner of an interposed box,
a feeding mechanism constructed to feed between the dies a continuous fastening-strip,
a pasting-mechanism for applying adhesive substance to the strip
and
a cutter for severing the strip into stay-strips of suitable lengths, substantially as described.

the cam wheel E, which cam groove is so shaped as to actuate said movable blade at the proper time to sever the strip, and having for this purpose a concentric part e^4 which acts to hold the movable blade elevated, and an inwardly-deflected part e^5, which acts to depress and elevate the said movable blade for severing the strip.

3. The combination with opposing clamping-dies having diverging working faces, said clamping dies being arranged to co-operate in pressing an adhesive fastening strip upon the corner of an interposed box,
feed rollers M N operating in connection with an elastic bed L consisting, etc., as above,
a pasting or gluing roller O mounted, etc., as above,
and
a stationary blade or cutter P and a vibrating knife or clamp Q, etc., as above.

It is submitted, in view of these limitations, that the sweeping conclusions of the Court of Appeals for the First Circuit touching the scope of the first three claims are unsound, and that substantial justice to the petitioners and the public requires a definite declaration from this Court touching the scope of Beach's patent monopoly. Is it for a result, or is it for the mechanisms to which the Commissioner tried to limit Beach, or is it for what Beach originally claimed, namely, a wholly new kind of a machine which applied stay-pieces (*a*) *without*, (*b*) ACROSS, *and* (*c*) WITHIN *the box-corner*, as shown in his patent figure 9?

NOTE.—Claims 1, 2, and 3, like petitioners' enjoined machines, relate merely to the application of stay-pieces on the outside only of box-corners, and therefore eliminate the "secondary plunger" or down-turner H, and the "follower which moves inward to carry the project-

ing end under the edge of the box," or inturner I. (See Fig. 9.) These were elements of Beach's original claims. His original application contained no suggestion of inventorship of the simple combination of claims 1, 2, 3, and 5.

Because of these facts and limitations, petitioners submit that the doctrine of the Second Circuit is also unsound, and seek to have that doctrine qualified in order that their machines within the Second Circuit may be changed over to avoid infringement if the doctrine of the First Circuit is correct.

Third. Petitioners seek to have this Court, at the proper time, declare claims 1, 2, 3, and 6 void for want of patentable invention, in order that they may continue to operate under their prior Horton patent. Thinking that this Court may now wish to consider briefly the question of whether it is probable that the inferior courts mentioned have failed to do substantial justice, both as regards petitioners and also as regards the public, the following is submitted:

Beach did not originally claim any mechanisms for staying the outsides only of box-corners. The use of angularly-faced dies for attaching corner clasps to interposed box-corners was old and well-known in machines of which the Cohn patent machine is a type (No. 148,416, p. 453). The Haddan patent of 1884 (British 16,137, p. 511) intermittently fed a wire from a reel; cut off short pieces, one by one, and forced them into "the edges of pasteboard boxes" (see Haddan's specification, p. 2, line 31), the boxes being supported on an angularly-faced anvil, and the plunger having a corresponding notch in its under face. (See Fig. 2 of Haddan patent.)

The paper-box machines of the Maxfield (p. 525) and Terry (p. 531) patents of 1866 and 1859, respectively, mechanically applied to the paper-box corners a strip of

glued or otherwise adhesive paper. The boxes operated were round boxes and the corners were at the junction of the round side walls with the bottoms. Therefore Beach was not the first to achieve the generic result of a mechanically stayed paper-box corner. But as years went by and angular boxes came to be more and more used, it became frequently necessary to strengthen their angular corners at the junction of two sides.

Beach's original application (p. 261) states:

"It has been customary heretofore in making paper or strawboard boxes to apply a stay or fastening strip over the joints at the corners [formed by the junction of two flat sides] of the boxes, which strip is [either] [*A*] pasted down on the outside of the box, or is [*B*] folded over the edge of the box and secured by paste both outside and inside the corner, and such work, as far as I am aware, has heretofore been done by hand."

This statement is doubtless correct, and Beach's original specification and claims were wholly addressed to combinations for doing the *latter* species [*B*] of corner-staying. And this was natural enough, because his original attorney, R. F. Osgood, had previously solicited the Welch patent No. 236,387 of January 4, 1881 (p. 537), in which an addressing machine containing the elements of Beach's present, first, second, and third claims in a combination that does not differ, mechanically, from Beach's, except in the shape of the faces of the co-operating pressing members or dies.

In the first case, in the Northern District of New York, Judge Coxe considered the prior Dennis & York addressing machine (No. 303,922, p. 547), and disposes of it as an anticipation by saying that the follower is "supported upon light coiled springs." (Beach *v.* American Box Machine Co., 63 Fed. Rep., 600, 601). But the prior patent to Welch states that the follower, that is,

the work-support, may be "held stationary for the purpose of labeling separate papers when desired," just as Beach's work-support is held stationary for the purpose of staying separate boxes.

Neither Beach nor his attorney, Osgood, appear to have thought, when Beach's original application was filed, that there was any invention in making the opposing faces of the addressing machine plunger and follower angular instead of flat, and using such structures for applying stay-pieces to the *outside only* of interposed box corners. Complainant's expert, Breevoort, admits, in substance, that a very large box could be stayed on the Welch patent machine if the pressing members had the proper shaped working faces.

Brevoort, Ans. 11 and 12, pp. 237, 238.

It is submitted that substantial justice to the public, the petitioners, and to users of their machines scattered through numerous States requires final consideration of the questions of patentability involved in the first, second, third, and sixth claims of this Beach patent, now rendered indefinite and uncertain by reason of the antagonistic conclusions of two different Courts of Appeal.

The following points are submitted as additional reasons why the writ should be granted:

1. It is submitted that the Beach patent is void, because it clearly appears that the original patent was neither inoperative nor invalid to any extent or in any degree whatsoever. The statute does not authorize *any* reissue whatever unless the original *patent* is either "inoperative or invalid." (U. S. Rev. Stats., 4916, line 1.) All decisions to the contrary are in violation of the clear and express words of the statute. This Court has never decided this point. It is submitted that the courts have wholly and plainly erred in sustaining Beach's reissue.

The original patent drawings contained a draughtsman's error (see Beach Reissue File Wrapper, p. 289) in one figure,—an obvious error, Beach testifies. Beach's remedy was by a certificate of correction, under the Patent Office Rule 170, and not by a reissue. The Commissioner had no final jurisdiction over the first and fundamental question of whether Beach's original patent was "invalid or inoperative." The statute is clear—there *shall be no valid reissue whatever unless the original patent is, as a* PATENT, *either invalid or inoperative.* If Beach's original patent were in suit and it should be argued that it was either invalid or inoperative in any respect whatever, the advocate would be laughed out of court.

"A draughtsman's error can not militate against a patent."

Consolidated Brake Shoe Co. *v.* Detroit Steel & Spring Co., 59 Fed. Rep., 903.

In Giant Powder Co. *v.* California Vigorit Co., 4 Fed. Rep., 720, Mr. Justice Field perceived the exact point now raised. The learned Justice observed, at pp. 724, 725:

"Suppose, for illustration, that the specifications in two patents, the original and the reissue, were identical in their language, or, differing in phraseology, were identical in meaning, would it be pretended that, *though* their identity would be thus manifest on their face from a comparison of the two, and that *the Commissioner, in granting the reissue, had accordingly acted in a case not warranted by the statute,* it must be assumed that the reissue was properly granted, and that the action of the Commissioner could not therefore be questioned? The decision supports no such conclusion."

But note pp. 723–725.

Mr. Beach testifies (pp. 105 and 106) as follows respect-

ing the error on account of which the reissue was obtained:

"Cross-Int. 54. Do you think that any person skilled in the art of making paper-box machinery would have any substantial difficulty in fully understanding the machine set forth in your original patent, No. 447,225, from the drawings and specifications thereof?

"Ans. I do not.

"Cross-Int. 55. The construction and operation of your patented machine and the nature of your invention, and all the features thereof, were set forth in your original patent, No. 447,225, with substantial accuracy, were they not?

"Ans. I supposed they were.

"Cross-Int. 56. And you still think so?

"Ans. I still think so.

"Cross-examination closed.

"*Redirect examination by* Mr. DANE.

"Redirect Int. 57 [58]. What principal defect caused you to reissue the patent upon which this suit is based?

"Ans. An error in the drawings.

"Redirect Int. 59. Who made the error?

"Ans. The draftsman who inked the drawings.

"Redirect Int. 60. Was it or not an obvious error?

"Ans. It was."

2. The Horton patent being of prior date to Beach's bars the suit, it not appearing from the record whether Beach or Horton was the prior inventor of the combinations of Beach's claims 1, 2, 3 and 6. That Beach was the first to apply and the first to construct a machine is not sufficient to establish the question of prior inventorship between Horton and Beach; for in determining that question, the date of conception, disclosure, and the making of drawings or models are all elements to be consid-

ered, as well as the question of diligence in view of the circumstances of the rivals. Beach chose to sue, under his later patent, machines made under Horton's prior patent, and apparently relied on the notion that the mere facts of an earlier application (which did not contain or suggest the claims in suit) and of an earlier reduction to practice were sufficient to entitle his patent to rank as a prior patent. But in view of the enlargement of Beach's claims for the avowed purpose (see "Remarks" in support of Beach's amendment of November 7th, 1890, pp. 270, 271) of covering subsequently invented machines and of the rule of law prohibiting such enlargements (Railway Co. *v.* Sayles, 97 U. S., 554; Eagleton Manufacturing Co. *v.* West Manufacturing Co., 111 U. S., 490) it is submitted that substantial justice required Beach to conclusively prove as a part of his case every element necessary to establish priority of invention as against Horton, in order to lay good ground for sustaining that burden of proving infringement which is always on a complainant. (Fuller *v.* Yentzer, 94 U. S., 293.)

Moreover, as the Horton patent was granted without any interference with Beach, the legal presumption is that the Horton machine did not, in the opinion of the Commissioner at least, conflict with the Beach application machine, (Boyden Power Brake Co. *v.* Westinghouse Air Brake Co., 70 Fed. Rep., 816; affirmed in 170 U. S., 537), so that it was specially incumbent upon Beach to sustain the burden of proof of infringement by proving in the first place conclusively that his invention antedated Horton's and that his patent was in law a prior patent. And this especially forceful presumption of non-infringement is fortified and, it is submitted, rendered conclusive, by the fact that in every interference issue formulated by the Commissioner and involving the subject-matter of Beach's claims 1, 2 and 3, each mechanism was immediately fol-

lowed, and consequently specifically qualified, by the words "substantially as described."

See Marshall *v.* Beach issue, p. 254;
Jaeger *v.* Beach issue 1, p. 258;
Knowlton *v.* Beach issue, p. 259;
Inman *v.* Beach issue, p. 260;
All in Defendant's Exhibit Beach File-Wrapper.

Again, in office letter of December 26th, 1890, p. 271, the Commissioner demanded the same limitation, the reason for which existed in the prior art, and this insistence was, moreover, justified by the peculiar construction and mode of operation of Beach's feeding mechanism as clearly set forth by Beach in his "Remarks," p. 270, of Defendant's Exhibit Beach File-Wrapper, etc. The substantial limitations imposed by the Commissioner upon Beach's first, second and third claims were clearly binding upon Beach (Phœnix Caster Co. *v.* Spiegel, 133 U. S., 368), and therefore it was peculiarly essential to Beach's case to prove every step necessary to establish priority of invention as against Horton in order to lay ground for further proof establishing infringement beyond a reasonable doubt.

To hold petitioners' machines as infringement of claims 1 and 2 was, it is submitted, a violation of McCarthy *v.* Lehigh Valley R. R. Co., 160 U. S., 116, because petitioners' machines contain a "severing mechanism" which is *not* an element of claim 1, and also contain a "pasting mechanism" which is not an element of claim 2. To hold that such machines infringe either claim 1 or claim 2 requires the omitted elements to be read into the claim and thus makes them for the same subject-matter as claim 3, while in fact claims 1 and 2 are for machines that are not wholly automatic, but require the operator to paste manually and to sever manually.

It is submitted,

(1) that the diversity of opinion between the Courts of Appeal for the First and Second Circuits, and

(2) that the seeming violation by both said Courts of the decisions of the United States Supreme Court touching the effect of limitations imposed upon claims by the Commissioner of Patents as prerequisites to allowance; and

(3) the alleged error of the Court of Appeals for the First Circuit in holding that the Horton peculiar and original back feed was a known substitute for the side feed of the Beach patent, because, forsooth, some other constructions of back feeds were known at the date of the Beach patent, render the grant of the writ of *certiorari* peculiarly proper in the interests of substantial justice and for final settlement of what scope the Beach patent is to be given for the remainder of its term, within and throughout the United States and the Territories thereof, even supposing that Beach's reissue is valid in spite of the explicit language of the statute to the contrary.

Very respectfully submitted.

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EDWARD S. BEACH,
Of Counsel for Petitioners.

WASHINGTON, D. C.,
September 11, 1899.